APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,306	06/22/2001	Rogelio Robles	10990665-1	6814

7590   03/29/2005

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/887,306	ROBLES ET AL.
	Examiner	Art Unit
	CESAR B. PAULA	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.　　　This action is responsive to the amendment, and 37 CFR 1.131 affidavit filed on

12/10/2004.

This action is made Final.

2.　　　In the amendment, claims 1-40 are pending in the case. Claims 1, 9, 19, and 29 are

independent claims.

Drawings

3.　　　The drawings filed on 6/22/2001 have been approved by the examiner.

Response To Declaration under 37 CFR § 1.131

6.　　　The Affidavit filed on **12/10/2004** under 37 CFR 1.131 has been considered but is

ineffective to overcome the effective filing date of the Van Der Linden US Patent Publication,

8/16/2001, filed on 12/28/2000, Foreign EPO application filed on 1/4/2000.

　　　The evidence submitted is insufficient to establish a reduction to practice of the invention

in this country or a NAFTA or WTO member country both prior to, and after the effective date

of the Van Der Linden reference, up to the date of constructive reduction to practice (i.e. filing

date of the present application).

In addition, the evidence submitted is insufficient to establish diligence from a date prior

to the date of reduction to practice of the Van Der Linden reference to either a constructive

reduction to practice or an actual reduction to practice.

Moreover, each exhibit relied upon should be specifically referred to in the declaration in

terms of what it is relied upon to show. The declaration must clearly explain which <u>facts or data</u>

applicant is relying on to show that the invention was completed prior to a certain date. There is

no explanation as to how "Exhibit A" relates to the claimed invention. The declaration does not

show which claims are supported by exhibit A, and which limitations are supported by a certain

portion of the exhibit. In addition, the description of the invention does not appear to be part of

the disclosure in exhibit A, because the Exhibit only contained 2 (page 2) not 7 pages, as it is

implied by the exhibit.

Further, the applicant must clearly explain the exhibits, drawings, or any evidence which

forms part of the declaration, to point out exactly what facts are established and relied upon to

support the declaration, in order to meet the statutory requirements of 37 CFR 1.131. There is no

explanation detailing in what manner the figures submitted support the claimed invention.

The applicant has included a general and vague statement as to when the invention was

conceived (including what seems a correction of the "Jan 25 1998", by replacing 1998 with 1999

in pen, o page one of two), and the proof of conception, and reduction to practice. <u>A mere</u>

<u>statement declaring that the invention was conceived or reduced to practice by a specific date</u>

<u>predating the applied prior art reference is insufficient to satisfy 37 CFR 1.131</u>.

Exhibit A, and the description of the invention just present vague evidence of diligence

and reduction to practice at best. However, it is not clear from these exhibits what the invention

was or which claims, drawings, etc., were being referred to. For example, the description of the

invention does not seem to be part of exhibit A. Since these exhibits only describe ancillary

statements of the conception of the invention, not reduction to practice date, and not the <u>facts</u>

<u>established and relied upon</u> supporting the statements of the applicant, they do not represent

enough information to meet the requirements of 37 CFR 1.131.

In general, proof of actual reduction to practice requires a showing that the apparatus

actually existed and worked for its intended purpose. This proof is demonstrated with

<u>satisfactory evidence of facts</u> supporting priority of invention, said proof usually in the form of

exhibits. Examples of support include attached sketches, blueprints, photographs, reproduction of

notebook entries, accompanying models, supporting statements by witnesses, interference

testimony, and/or prior submission to the USPTO of Disclosure Documents.

In view of the examples of support as explained above, it is the Examiner's opinion that

the presented combination of evidence within exhibit A (a signed copy of an invention disclosure

not clearly explaining which facts are relied upon to back up the conception, and reduction dates

of the invention), is insufficient proof that Applicant's invention was conceived and/or reduced

to practice before the filing date of Van Der Linden. Accordingly, said affidavit is ineffective to

overcome the effective filing date of the Van Der Linden reference at the present time (see

MPEP 8th Edition, section 715.07).

Claim Rejections - 35 USC § 112

4.   Appropriate corrections have been made to claims 32, 38 . Therefore the rejections of

claims 32-40 under 35 U.S.C. 112, second paragraph, have been withdrawn.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.   Claims 1-18, 24, and 35 remain rejected under 35 U.S.C. 102(e) as being anticipated by

Van Der linden et al, hereinafter Vanderlinden (US Pub.# 2001/0013947 A1, 8/16/2001, filed

12/28/2000, Foreign EPO application filed on 1/4/2000).

Regarding independent claim 19, Vanderlinden discloses the submission of print jobs to a

reproduction center using a print driver—*capture driver operable to capture the document*

production request, which generates a temporary print file. A submission form, which is

displayed by a browser—*interface translator--*, has pull-down menus, and control buttons for

selecting printers, and print options, and submitting the print job (0038-0046, fig.,3).

Furthermore, a reproduction center—*production server--* is connected with a client via a

network, for routing the print job according to the selected printers and print options—*direct one*

or more selected devices to produce the captured document, to a printer which capable for

executing this job. The submission form includes messages for displaying the change in devices

capabilities—*potential services* offered by the reproduction center--as a result of automatic

updates of the submission form. A scheduler—*production engine*-- routes the print jobs to the

appropriate printers to complete the job (0035, 0042-0044, 0048-0049,0059-0060).

Regarding claim 20, which depends on claim 19, Vanderlinden discloses the submission

of print jobs to a reproduction center using a print driver, which generates a temporary print file

version of the document (in Postscript printer language) to be printed. Once entries have been

made, the submission form is transmitted to the reproduction center (0046-0048).

Regarding claim 21, which depends on claim 19, Vanderlinden discloses the submission

of print jobs, using a submission form, to a reproduction center by a client computer over a

network. The submission form is displayed by a browser—*interface translator*-- (0035-0041,

fig.,3).

Regarding claim 22, which depends on claim 21, Vanderlinden discloses the automatic

update—*identify services available on the network*-- of the submission form to include a

description outlining change in devices capabilities (0051, 0059,fig.3).

Regarding claim 23, which depends on claim 21, Vanderlinden discloses the use or query

of a device capability store—*database of known services*-- for automatically updating the

submission form to include a description outlining change in devices capabilities (0051,

0059,fig.3).

Regarding claim 25, which depends on claim 19, Vanderlinden teaches the editing or

changing of the submission form's pull-down menu—*device identifier to identify* printers

available at the reproduction center-- to update functionalities available at the reproduction

center, such as the adding a new printer to a pull-down menu for selecting the printer, as a result

of the addition of a new printer capable of printing transparent. The updated information is

placed, and displayed in the form's pull-down menu using a browser (0016, 0041, 0051, 0059,

fig.3).

Regarding claim 26, which depends on claim 19, Vanderlinden discloses that the

reproduction center has a print queue for placing waiting-to-be-processed print jobs (0056,fig.3).

Regarding claim 27, which depends on claim 26, Vanderlinden discloses that the

reproduction center has an operator console for displaying waiting-to-be-processed print jobs

from the print queue (0056,fig.3).

Regarding claim 28, which depends on claim 19, Vanderlinden discloses a program

module for establishing a network connection with the reproduction center—*locating* a print

server (0040).

Regarding independent claim 29, Vanderlinden discloses a print server computer—

second computing device-- is connected to a client computer—*first computing device--* via a

network, for routing the print job according to selected printers—*document production devices--*

and print options, to a printer which capable for executing this job. The print job is sent to the printer and printed in a PDF format—*device specific format* (0035-0041, 0048-0050,0059-0060, fig.1-2).

Regarding claim 30, which depends on claim 29, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver. An activation of the driver generates a temporary print file version of the document (in Postscript printer language) to be printed. The print file is transferred to the reproduction center to be printed. A submission form displayed on a browser—*Interface Translator*--, having buttons, and menus for formatting the document which is to be printed (0037-0048, fig.3).

Regarding claim 31, which depends on claim 30, Vanderlinden discloses the submission of print jobs to a reproduction center using a print driver. An activation of the driver generates a temporary print file version of the document (in Postscript printer language—*generic format*) to be printed. The print file is transferred to the reproduction center to be printed (0037-0041, fig.1-2).

Regarding claim 32, which depends on claim 29, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities—*potential services* offered by the reproduction center--as a result of automatic updates of the submission form. A scheduler—*production engine*-- routes the print jobs to the appropriate printers to complete the job (0035, 0042-0044, 0048-0049,0059-0060).

Regarding claim 33, which depends on claim 32, Vanderlinden discloses the submission

of print jobs to a reproduction center's print server, using a submission form. The submission

form is displayed on a browser—*Interface Translator*--, having buttons, and menus for

formatting the document which is to be transferred printed (0041-0048, fig.1-3).

Regarding claim 34, which depends on claim 32, Vanderlinden discloses the use or query

of a device capability store—*services database* -- for automatically updating the submission

form to include a description outlining change in devices capabilities. The device capability store

is also used for routing the documents to be printed (0051, 0059,fig.3).

Regarding claim 36, which depends on claim 34, Vanderlinden discloses the submission

form includes messages for displaying the change in printing devices capabilities as a result of

updates made to the device capabilities store—*services database updated with services not

currently represented in this database*-- (0059-0060).

Regarding claim 37, which depends on claim 36, Vanderlinden discloses the update or

addition—*identification new devices*-- of new printers to a device capabilities store. Each printer

is associated with a corresponding print driver (0037-0038, 0051, and 0059).

Claims 38-40 are directed towards a computer system for implementing the steps found

in claims 25, and 27-28 respectively, and therefore are similarly rejected.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-18, 24, and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable

over Vanderlinden.

        Regarding independent claim 1, Vanderlinden discloses the submission of print jobs to a

reproduction center, where documents are to be printed upon the receipt of a submission form.

The submission is transmitted by a client—*first computing device*-- through a submission form—

production request—which indicates controls for allowing a user to select print options—

services-- currently available at the reproduction center (0010, 0016, fig.1-2, 3).

        Furthermore, Vanderlinden teaches creating a job ticket, containing job specifications—

merging selected services and captured document production request into a production plan--

found on the form submitted by the client. The print job ticket—*production plan*-- is then routed

to a printer capable of printing the document (0011, 0050, 0060, fig.3). Vanderlinden fails to

explicitly disclose: *delivering the document production plan in a device specific format.*

However, it would have been obvious to a person of ordinary skill in the art at the time of the

invention to have delivered the plan in a device specific format, because Vanderlinden teaches

above routing job tickets to a printer capable of executing the job at the lowest possible costs.

Thus printing documents at a minimum price at a printer which understands and is able to carry

out the print request.

Regarding claim 2, which depends on claim 1, Vanderlinden teaches the changing of the

submission form to update capabilities available at the reproduction center, such as the adding a

new printer to a pull-down menu as a result of the addition of a new printer capable of printing

transparent (0051).

Regarding claim 3, which depends on claim 2, Vanderlinden teaches the changing of the

submission form to update capabilities available at the reproduction center, such as the adding a

new printer to a pull-down menu as a result of the addition of a new printer capable of printing

transparent (0051).

Regarding claim 4, which depends on claim 2, Vanderlinden teaches the changing of the

submission form to update capabilities available at the reproduction center, such as the adding a

new printer to a pull-down menu as a result of the addition of a new printer capable of printing

transparent (0051). In other words, when the new printer is detected or queried by the client

computer, then the update will take place on the submission form.

Regarding claim 5, which depends on claim 2, Vanderlinden teaches the changing of the

submission form to update capabilities available at the reproduction center, such as the adding a

new printer to a pull-down menu as a result of the addition of a new printer capable of printing

transparent. The updated printer information is obtained from a device capability store—

querying a service database (0051, 0059).

Regarding claim 6, which depends on claim 1, Vanderlinden teaches the conversion of a

document submitted by the client, into a format, such as PDF—*generic format--* which is more

suitable for processing by the reproduction center (0051). In other words, when the new printer is

detected or queried by the client computer, then the update will take place on the submission

form.

Regarding claim 7, which depends on claim 1, Vanderlinden teaches the changing of the

submission form to update functionalities available at the reproduction center, such as the adding

a new printer to a pull-down menu for selecting the printer, as a result of the addition of a new

printer capable of printing transparent (0016, 0051, 0059, fig.3).

Regarding claim 8, which depends on claim 1, Vanderlinden teaches the display of a list

of all pending print jobs along with their current status, such as waiting, being printed, or is

completed (0056-0059). In other words, the status is monitored to determine the progress of the

print job, and then that status is displayed on the list.

Regarding claim 10, which depends on claim 9, Vanderlinden teaches the submission of a print job over a network to a reproduction center using a form displayed on a web browser (0040-0047).

Regarding claim 15, which depends on claim 14, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities as a result of updates made to the device capabilities store—*services database updated with services not currently represented in this database*-- (0059-0060).

Regarding claim 16, which depends on claim 15, Vanderlinden discloses the submission form includes messages for displaying the change in printing devices capabilities as a result of updates made to the device capabilities store—*services database updated with services not currently represented in this database*—such as the addition of new printers—*services not available on the network and services database and updating the database with* the new printer added to the reproduction center (0051, 0059-0060).

Claims 9, 11-14, 17-18 are directed towards a computer program product on a computer-readable medium for storing the steps found in claims 1-5, and 7-8 respectively, and therefore are similarly rejected.

Regarding claim 24, which depends on claim 23, Vanderlinden discloses the use or query of a device capability store—*database of known services*-- for automatically updating the

submission form to include a description outlining change in devices capabilities. This invention also indicates the print status of printers, whether or not a print job is being printed or is completed (0056). Vanderlinden fails to explicitly disclose: *querying the document production devices*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have query the printers for their status, because this provides the benefit of quickly informing the user of the condition of a print job, so that the user would take necessary steps in case of a malfunction or printer error.

Regarding claim 35, which depends on claim 34, Vanderlinden discloses the use or query of a device capability store—*services database* -- for automatically updating the submission form to include a description outlining change in devices capabilities. The device capability store is also used for routing the documents to be printed (0051, 0059,fig.3). Vanderlinden fails to explicitly disclose: *querying the document production devices*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have query the printers for their status, because this provides the benefit of quickly informing the user of the condition of a print job, so that the user would take necessary steps in case of a malfunction or printer error.

Response to Arguments

9.   Applicant's arguments filed 12/10/2004 have been fully considered but they are not persuasive. Applicants indicate that the 131 affidavit establishes both a conception, diligence, and constructive reduction to practice (page 1 of the remarks). As set forth above, the 131

declaration is insufficient to establish conception, diligence, and reduction to practice before the

Vanderdinden reference. Therefore, claims 1-40 remain rejected.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least

one business day.

Any response to this Action should be mailed to:

> Commissioner for Patents
> P.O. Box 1450
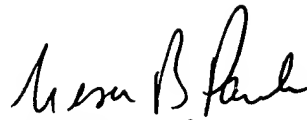
Alexandria, VA 22313-1450

Or faxed to:

- **(703) 703-872-9306, (for all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER

3/28/05